REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed November 22, 2004. Currently, Claims 80-116 are pending.

Objection to the Drawings

The drawings have been objected to as including shading that obscures text. Applicants respectfully submit herewith a substitute set of drawings.

Obviousness-Type Double Patenting Rejection of Claims 80-116

Claims 80-116 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-79 of copending Application No. 09/753,537 in view of 09/753,643.

Claims 80-116 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-79 of copending Application No. 09/753,537 in view of 09/753,644.

The basis for this rejection is not clear. As best understood, both of the provisional rejections based on obviousness-type double patenting appear to reject the claims of the present invention in part over "Claims 1-79 of co-pending Application No. 09/753,537." However that application is not copending. That application is in fact the present invention. Moreover, Claims 1-79 of the present invention have been canceled from the present application in favor of new Claims 80-116. Thus, it is unclear how claims in the present invention could be rejected under obviousness-type double patenting in part based on claims that were canceled from the present invention.

To the extent the rejection is based solely on 09/753,643 (in the first double patenting rejection) and 09/753,644 (in the second double patenting rejection), applicants respectfully note that the claims in each of those references are significantly different than the claims of the present invention.

It is therefore respectfully requested that the obviousness-type double patenting rejections on the stated grounds be withdrawn.

Rejection of Claims 80-83, 88-104 and 106-116 Under 35 U.S.C. §102(b)

Claims 80-83, 88-104 and 106-116 are rejected under 35 U.S.C. §102(b) as being anticipated by Morris U.S. Patent No. 5,574,906 ("Morris"). Claims 91-108 have been canceled and it is respectfully requested that the rejection on these grounds be withdrawn. Applicants respond to the rejection of Claims 80-83, 88-90 and 109-116 as follows.

Morris relates to a network storage system. In such systems, data, programs, etc. of an end user, or client, are stored on a server to which the client is networked. In the system of Morris, when a file on the client is changed, the change is compared against a base (prior version) of the file (either in the client or in the server). The comparison generates a delta file, which is then stored on the server and used to define a new base file representing that data. Storing only the delta file allows Morris to recognize advantages in the reduction of storage space required.

A significant distinction between the claims of the present invention and the disclosure of Morris is that Morris does not disclose, teach or suggest a synchronization system. In particular, Morris generates a delta file for changes solely for use in backing up a file on the server. The delta file is not used to synchronize the changed file to other devices networked to the server. The delta file is simply stored on the network server.

By contrast, the present invention generates differencing information and then uses that information to synchronize other devices. This feature is expressly recited in Claims 80-90 as amended, which recite in part:

> a transaction generator providing at least one binary difference transaction including said binary differencing data to an output for forwarding to a network coupled server, ***the server using the binary differencing data to synchronize at least one other network coupled processing device.***

In embodiments, the transaction generator provides the differencing data "to an output" for use in synchronizing other devices. This feature is nowhere disclosed, taught or suggested in Morris. The delta file in Morris is not provided to an output by the server. It is simply stored in the server. Again, this is because the system of Morris is simply provided to backup data. Morris does at points discuss whether the new file from the client and the backup file are "in synch." However, it does not disclose synchronization of data by outputting differencing information.

Similarly, independent Claim 109, and Claims 110-115 dependent thereon, each recite in part:

> a transaction generator providing at least one binary difference transaction including said binary differencing data ***to an output of the network coupled server.***

In embodiments, the transaction generator provides the differencing data "to an output of the network coupled server" for use in synchronizing other devices. This feature is nowhere disclosed, taught or suggested in Morris. The delta file in Morris is not provided to an output of the server. It is simply stored. Again, this is because the system of Morris is simply provided to backup data. Morris does not disclose synchronization of data by outputting differencing information.

Moreover, Claim 116 recites in part:

> at least a first binary differencing engine coupled to a first network coupled device;
>
> at least a second binary differencing engine coupled to a second network coupled device; and
>
> a storage device coupled to the first and the second network coupled devices storing binary differencing data from and outputting binary differencing data to said at least first and second binary differencing engines.

As set forth above, Morris has no disclosure of outputting binary differencing data to first and second binary differencing engines.

Each claim limitation must be found in a single prior art reference to support a rejection under §102. *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20 (Fed. Cir. 2000). Omission of any claimed element, no matter how insubstantial, is grounds for traversing a rejection based on §102. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983). As Morris fails to disclose the above-described claim limitations, it is respectfully requested that the rejection of Claims 80-90 and 109-116 be withdrawn.

Based on the above amendments and these remarks, reconsideration of Claims 80-90 and 109-116 is respectfully requested.

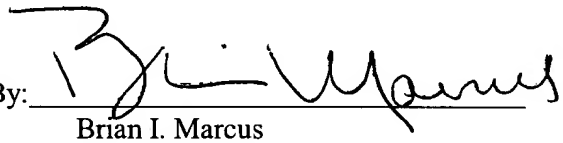
The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, May 23, 2005.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: May 23, 2005

By: 

Brian I. Marcus
Reg. No. 34,511

VIERRA MAGEN MARCUS HARMON & DENIRO LLP
685 Market Street, Suite 540
San Francisco, California 94105-4206
Telephone: (415) 369-9660
Facsimile: (415) 369-9665